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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,527	10/12/2001	Robert B. Blake	0290.00004	2471

7590 05/29/2003

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EXAMINER

BURCH, MELODY M

ART UNIT PAPER NUMBER

3683

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,527

Applicant(s)

BLAKE, ROBERT B.

Examiner

Melody M. Burch

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 19 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 41256
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - In line 2 of pg. 7 "21" is used to designate a lock pin but was previously used to designate an aperture.

Appropriate correction is required.

Claim Objections

2. Claims 7, 14, and 17 are objected to because of the following informalities:

Re: claims 7 and 17. The phrase "said first hinge knuckle" should be changed to --said at least one first hinge knuckle-- to maintain consistent terminology. The same issue holds true for the second hinge knuckle. Appropriate correction is required.

Re: claim 14. The phrase "include at least" should be changed to --includes at least--.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claims 14, 18, and 19. The phrase "said sidewalls" first claimed in line 2 of claim 14 lacks proper antecedent basis in the claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4730841 to Ponder. Ponder shows in figures 1 and 3 a trailer hitch cover assembly comprising: a main body 10 for connection to a hitch tube and having a front face with an opening in the form of a recess shown in the area of element 12 adapted to allow passage of a hitch into an open end of the hitch tube, a movable cover plate 14 hingedly connected to the main body to be moved between a first position and a second position, wherein the main body includes a plurality of apertures shown in the are of element 30 on either side of element 28 extending through the sidewalls shown in the area of element 22 on either side of element 28.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3683

8. Claims 1-8, 10-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4196918 to Strader in view of US Patent 4730841 to Ponder.

Re: claims 1, 3, 4, 8, 10-12, 14, 18, 20. Strader shows in figures 1 and 4 a trailer hitch cover assembly comprising: a main body 16,34,36 adapted to be disposed over a hitch tube 22,28 and adapted to allow insertion of a hitch into the hitch tube, an insulating member 88,70,72 adapted to be disposed over the hitch tube and between the main body and the hitch tube, but does not show the limitation of a cover plate hingedly connected to the main body and being movable between a closed position and a open position.

Ponder teaches in figures 1 and 3 the use of a hitch device cover assembly having a cover plate 14 hingedly connected to a main body 10 and being movable between a closed position and an open position. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the hitch cover assembly of Strader to have included a hitch device cover assembly having a rotatable cover plate, as taught by Ponder, in order to provide a cover assembly structure that enables the locking of the hitch device to prevent theft of a towed trailer vehicle as taught in the abstract of Ponder.

Re: claims 2 and 13. Strader shows in figure 4 the main body including at least one deflectable tab 46 to retain the main body on the hitch tube by way of element 38 and element 18.

Art Unit: 3683

Re: claims 5-7 and 15-17. Strader, as modified shows the limitation of at least one first hinge knuckle shown in the area of element number 26 of Ponder and at least one second hinge knuckle shown in the area of element number 26 shown opposite portion 28 and a hinge pin 30. See figure 1 of Ponder.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 18 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09982619 in view of US Patent 5603178 to Morrison. Both applications claim a trailer hitch cover assembly comprising a main body or hitch insert having an aperture or opening, a movable cover plate hingedly connected or rotatable door, and the main body or insert including at least one aperture extending through the sidewalls, but the instant application does not include the limitation of the cover assembly being used for a motor vehicle and the '619 application does not include the limitation of the at least one aperture being a plurality of apertures.

Art Unit: 3683

Morrison shows in the figure on the front of the patent a hitch cover assembly being used for a motor vehicle 14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the hitch cover assembly of the instant invention to have been utilized in the environment of a motor vehicle to protect the hitch tube of the vehicle from debris.

With regards to the plurality of apertures. In *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the courts held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the at least one aperture of application '619 to have included a plurality of apertures in order to provide additional holes to reliably connect with the locking pin.

This is a provisional obviousness-type double patenting rejection.

11. Claims 1, 12, and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6176506 to Blake in view of Morrison and Ponder. Both application and patent claim a trailer hitch cover assembly comprising a hitch insert or main body having an aperture or opening, an insulating member or anti-vibration mechanism between the hitch insert or main body and the hitch tube, and a cover plate but the instant application does not include the limitation of the cover assembly being for a motor vehicle, and the patent does not include the limitation of a cover plate being hingedly connected. The instant application is broader than the claim of the patent with respect to the top cover plate and is therefore covered by *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993) in

Art Unit: 3683

which the court held that for the purposes of obvious double patenting a later genus (broad) claim is not patentable over an earlier species (narrow).

Morrison shows in the figure on the front of the patent a hitch cover assembly being used for a motor vehicle 14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the hitch cover assembly of the instant invention to have been utilized in the environment of a motor vehicle to protect the hitch tube of the vehicle from debris.

Ponder teaches in figures 1 and 3 the use of a hitch device cover assembly having a cover plate 14 hingedly connected to a main body 10 and being movable between a closed position and an open position. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the hitch cover assembly of the patent to have included a hitch device cover assembly having a rotatable cover plate, as taught by Ponder, in order to provide a structure that enables the locking of the hitch device to prevent theft of a towed trailer vehicle as taught in the abstract of Ponder.

12. Claims 1, 12, and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5934699 to Blake in view of Strader. Both application and patent claim a trailer hitch cover assembly comprising a hitch insert or main body having an aperture or opening, and a cover plate or door hingedly or pivotally connected, but the instant application does not include the limitation of the cover assembly being for a motor vehicle or the limitation of a top cover plate and a front cover plate and the patent does

Art Unit: 3683

not include the limitation of an insulating member. The instant application is broader than the claim of the patent with respect to the top and front cover plates and the functional use in a motor vehicle environment and is therefore covered by *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993) in which the court held that for the purposes of obvious double patenting a later genus (broad) claim is not patentable over an earlier species (narrow).

Strader teaches in figures 1 and 4 the use of an insulating member 88,70,72 adapted to be disposed over the hitch tube and between the main body and the hitch tube. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cover assembly of the Blake patent to have included an insulating member, as taught by Strader, in order to provide a means of absorbing vibrations between the two components.

Allowable Subject Matter

13. Claims 9 and 19 are allowed.

Response to Arguments

14. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3683


Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mmb 5/19/03
mmb
May 19, 2003


JACK LAVINDER
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